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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,954	01/20/2004	Herbert Martin	60,126-220	1463

27305 7590 02/15/2005

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EXAMINER

BALSIS, SHAY L

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,954

Applicant(s)

MARTIN ET AL.

Examiner

Shay L Balsis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/6/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 25 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 45 of copending Application No. 10652095. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application '095 teaches a pig comprising a body having a longitudinal axis and end portions. There is additionally sealing lips integral with the body spaced from the end portions that is resiliently biased against the internal surface of a conduit.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 17 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 26 of copending Application No. 10652095 in view of Lamb (USPN 1746733) or in view of Ando (USPN 4653134).

The application number 10652095 teaches a pig scraper having a length and a sealing lip extending and spaced from said body portion including an outer surface spaced from said

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internal surface of said conduit having an annular sealing edge adjacent a free end of the sealing lip including a first and second face extending at an angle to the internal surface of the conduit.

The application fails to teach that the first and second faces form an acute angle with a generally triangular cross section. Ando and Lamb teach pig scraper with a sealing lip having first and second faces extending from the lip to form an acute angle with a generally triangular cross section. It would have been obvious to one of ordinary skill in the art to have the first and second faces of application number 10652095 extend at an acute angle having a generally triangular cross section as taught by Lamb and Ando so that the lip will contact the pipe to be cleaned and remove any raw material adhering to the pipe and to create a seal between the wall of the pipe and pig.

This is a provisional obviousness-type double patenting rejection.

Claims 17 and 25 are directed to an invention not patentably distinct from claim 26 and 45 of commonly assigned 10652095. Specifically, the claims in the copending application are not distinct since the claims teach all the essential elements of the invention in the present application.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 10/652095, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting

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inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-21, 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando (USPN 4653134).

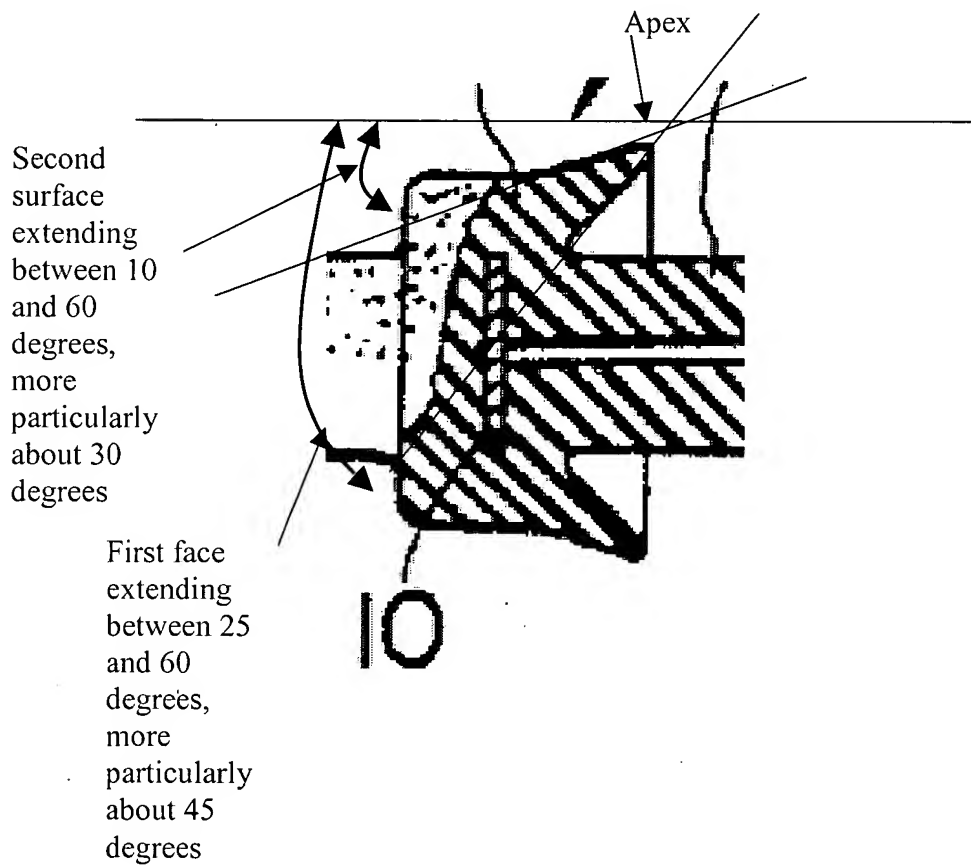
Ando teaches a pipe cleaner comprising a body (4) having a length, a longitudinal axis and opposed cylindrical end portions each having an end face. There is a sealing lip (1) integrally extending and spaced from the body portion. The outer surface of the lip is spaced from an internal surface of a conduit. The lip comprises a sealing edge, which is generally triangular in cross section. Adjacent a free end of the sealing lip are a first and second face extending at an acute angle to said internal surface of the conduit. There is an apex that is resiliently biased against the internal surface of the conduit and comprises a relatively sharp edge. The sealing lip has an axial length greater than 15% of an internal diameter of said internal surface of the conduit since the conduit used could be any size with any diameter. The first face

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of the sealing edge, adjacent the free end of the lip, defines an angle relative to the internal surface of the conduit of between 25 and 60 degrees, but more particularly about 45 degrees.

The second face of the sealing edge is spaced farthest from the free end of the lip and is defined at an angle relative to the internal surface of the conduit of between 10 and 60 degrees, but more particularly about 30 degrees.

See figure below.

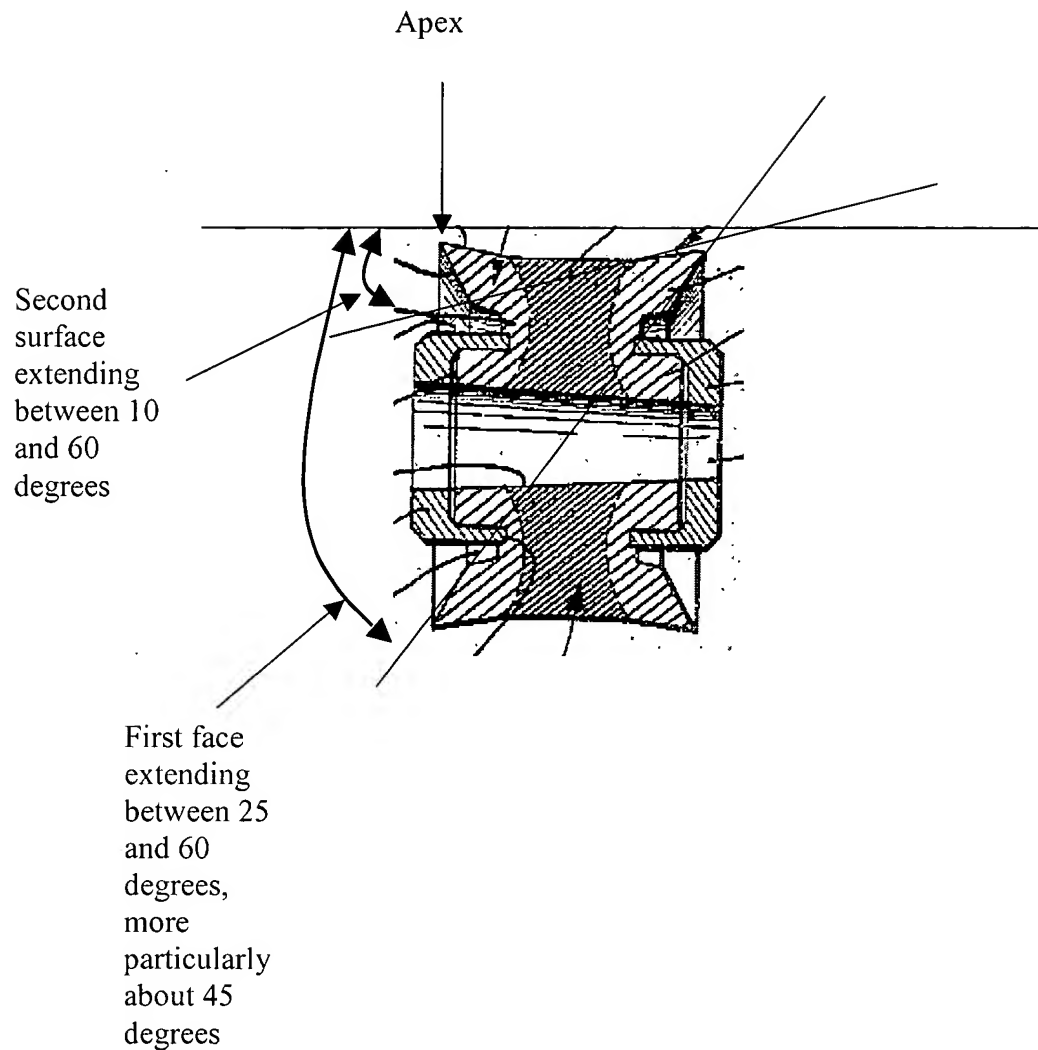


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Claims 17-20, 22-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamb (USPN 1746733).

Lamb teaches a pipe cleaner comprising a body (21, 39) having a length, a longitudinal axis and opposed cylindrical end portions each having a flat end face. There is a sealing lip (20) integrally extending and spaced from the body portion. The outer surface of the lip is spaced from an internal surface of a conduit. The lip comprises a sealing edge, which is generally triangular in cross section. Adjacent a free end of the sealing lip are a first and second face extending at an acute angle to said internal surface of the conduit. There is an apex that is resiliently biased against the internal surface of the conduit and comprises a relatively sharp edge. The sealing lip has an axial length greater than 15% of an internal diameter of said internal surface of the conduit since the conduit used could be any size with any diameter. The first face of the sealing edge, adjacent the free end of the lip, defines an angle relative to the internal surface of the conduit of between 25 and 60 degrees, but more particularly about 45 degrees. The second face of the sealing edge is spaced farthest from the free end of the lip and is defined at an angle relative to the internal surface of the conduit of between 10 and 60 degrees. See figure below.

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Response to Arguments

Applicant's arguments filed 12/16/04 with respect to Ando '134 have been fully considered but they are not persuasive. The arguments with respect to Le Devehat and Ando '927 have been considered and are persuasive. The rejections of Le Devehat and Ando '927 are withdrawn.

In response to applicant's argument that the Ando '134 patent is used to clean ducts and not conduits, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

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claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the Ando patent '134 is unidirectional, the Ando patent '134 are propelled by water pressure and none of the references teach a sealing edge that is self-sharpening) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the references fail to show cylindrical end portions is untrue and not persuasive. Ando '134 and newly cited reference Lamb both teach cylindrical end portions. Since the pipes that are being cleaned are cylindrical then the devices used to clean the pipes must also have a cylindrical profile in order to fit within the pipe and thoroughly clean the inside.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

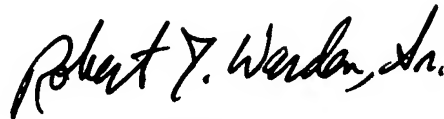
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shay L Balsis whose telephone number is 571-272-1268. The examiner can normally be reached on 7:30-5:00 M-Th, alternating F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 571-272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Slb
2/10/05



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